



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,064	10/31/2003	Simon Cohn	ETH5079	2592

27777 7590 10/06/2006

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

MENDOZA, MICHAEL G

ART UNIT PAPER NUMBER

3734

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,064

Applicant(s)

COHN ET AL.

Examiner

Michael G. Mendoza

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-24 and 27-30 is/are rejected.
- 7) ☒ Claim(s) 13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/31/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 20 and 22-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-15 of copending Application No. 10/699337. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application teaches the same method steps as the instant application, e.g., providing an instrument/retractor with a first manipulator, making an incision, creating a working space, and manipulating a vessel by rotating the first manipulator.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

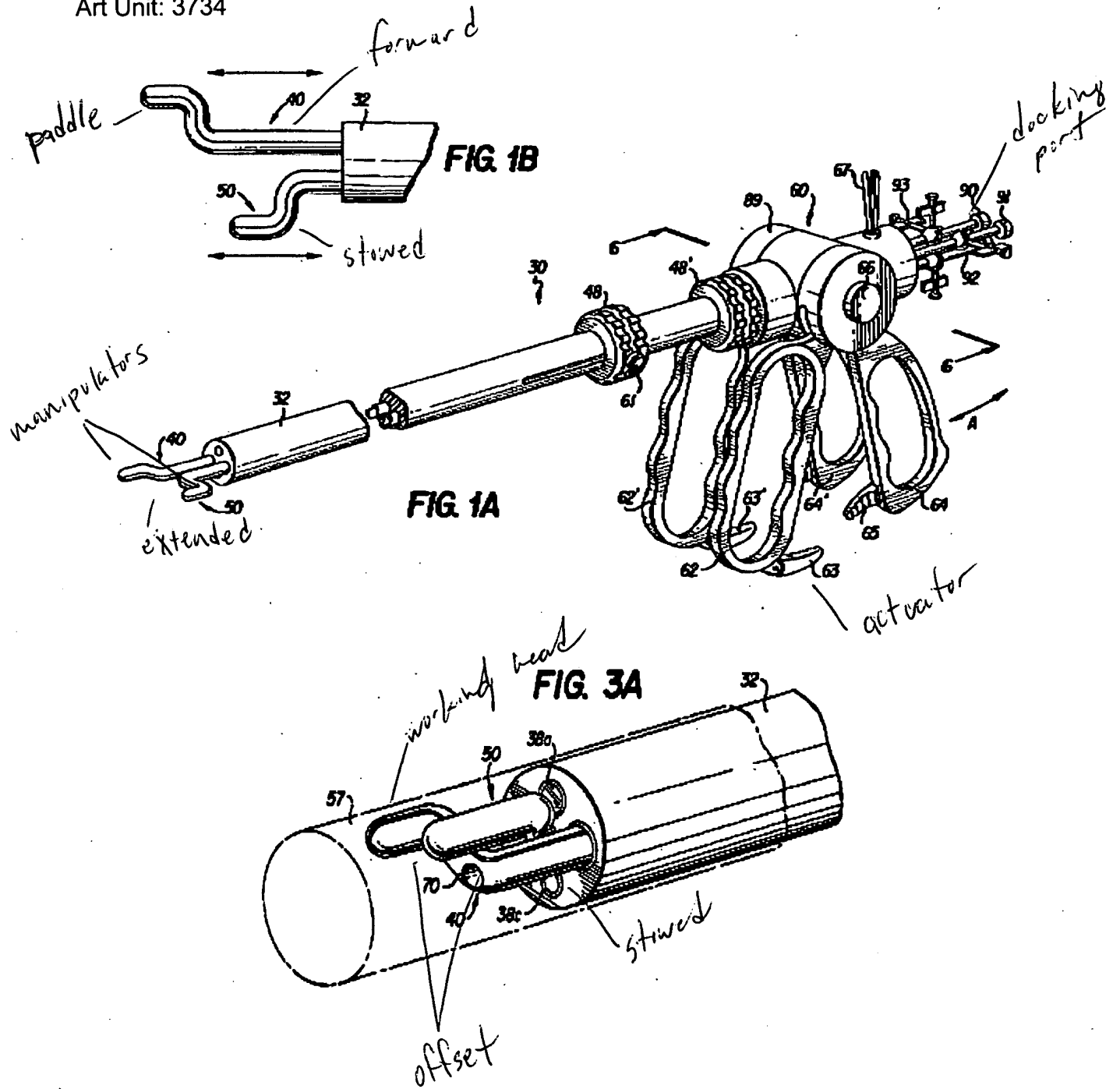
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-12, 15, 16, and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoon et al. 6017358.

5. Yoon et al. teaches an instrument for manipulation a vessel in a patient comprising: a working head shaped to define a working space; a first manipulator having a retracted position and an extending position; wherein the working head had a medial axis and the first manipulator is offset from the medial axis; wherein the first manipulator comprises a first rod having a distal and proximal end, the first rod being rotatably connected to the working head, and at least a first paddle connected tot a distal portion of the first rod; wherein the first rod is rotatably connected to the working head at the distal end of the first rod; wherein the paddle is shaped to nest within the working head when the first paddle is in the retracted position; wherein the first paddle extend at least partially outside the working space defined by the working head when the first paddle is in the extending position; wherein the first paddle has a curved

Art Unit: 3734

portion; wherein the curved portion forms a concave surface that faces away from the working head when the first paddle is in the extended position; a second manipulator comprising a second rod having a distal end and a proximal end, the second rod being rotatably connected to the working head, the second rod being spaced from the first rod; and a second paddle connected to a distal portion of the second rod, the second paddle having a retracted position and an extended position; wherein the first rod and the second rod extend distally in a longitudinal direction, and one of the first paddle and the second paddle is offset in the longitudinal direction with respect to the other of the first paddle and the second paddle; a handle; a shaft attached to the handle at a proximal end and attached to the working head at a distal end; at least a first actuator operably connected to the first manipulator for moving the first manipulator from the retracted position to the extended position; a first movable rack attached to the first actuator; and a first pinion engaged with the rack, the first pinion being connected to the proximal end of the first rod; a second actuator operably connected to the second manipulator for moving the second manipulator from the retracted position to the extended position; a second movable rack attached to the second actuator; and a second pinion engaged with the second rack, the second pinion being connected to the proximal end of the second rod; wherein the handle has a docking port that permits an instrument to be detachably attached to the handle.



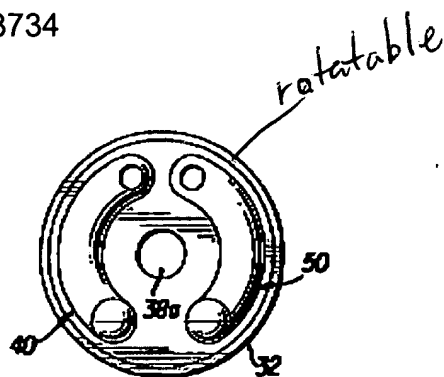


FIG. 17A

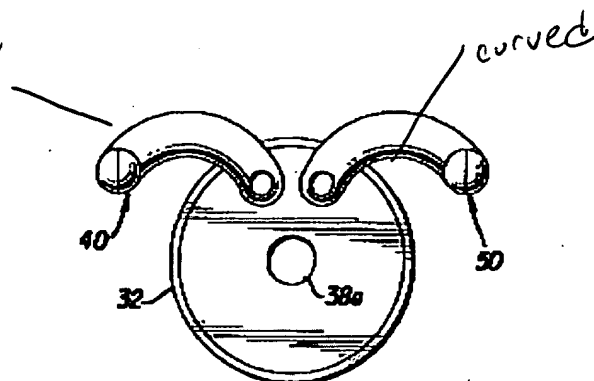
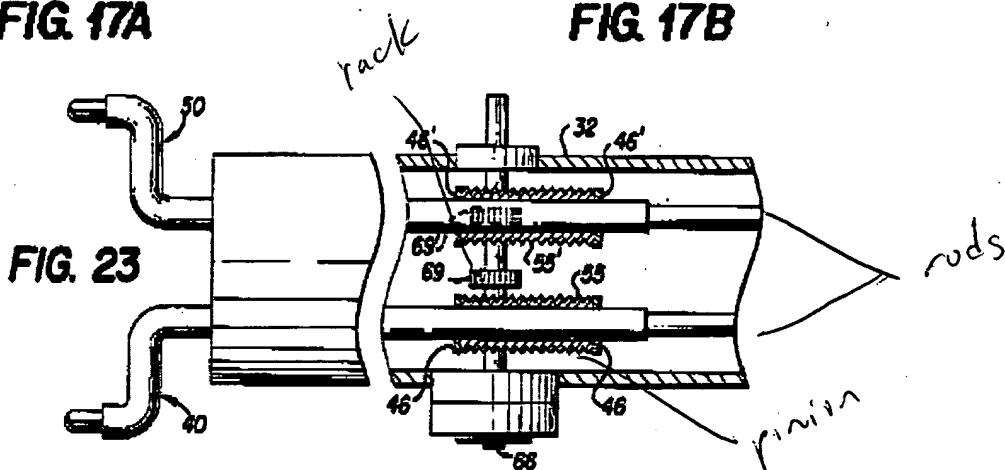


FIG. 17B



6. Claims 1-8, 11, and 17-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Weadock et al. 6527771.
7. As to claims 1-8, 11 and 17-19, Weadock et al. teaches an instrument for manipulation a vessel in a patient comprising: a working head shaped to define a working space; a first manipulator having a retracted position and an extending position; wherein the working head had a medial axis and the first manipulator is offset from the medial axis; wherein the first manipulator comprises a first rod having a distal and proximal end, the first rod being rotatably connected to the working head, and at least a first paddle connected tot a distal portion of the first rod; wherein the first rod is rotatably connected to the working head at the distal end of the first rod; wherein the paddle is shaped to nest within the working head when the first paddle is in the retracted position;

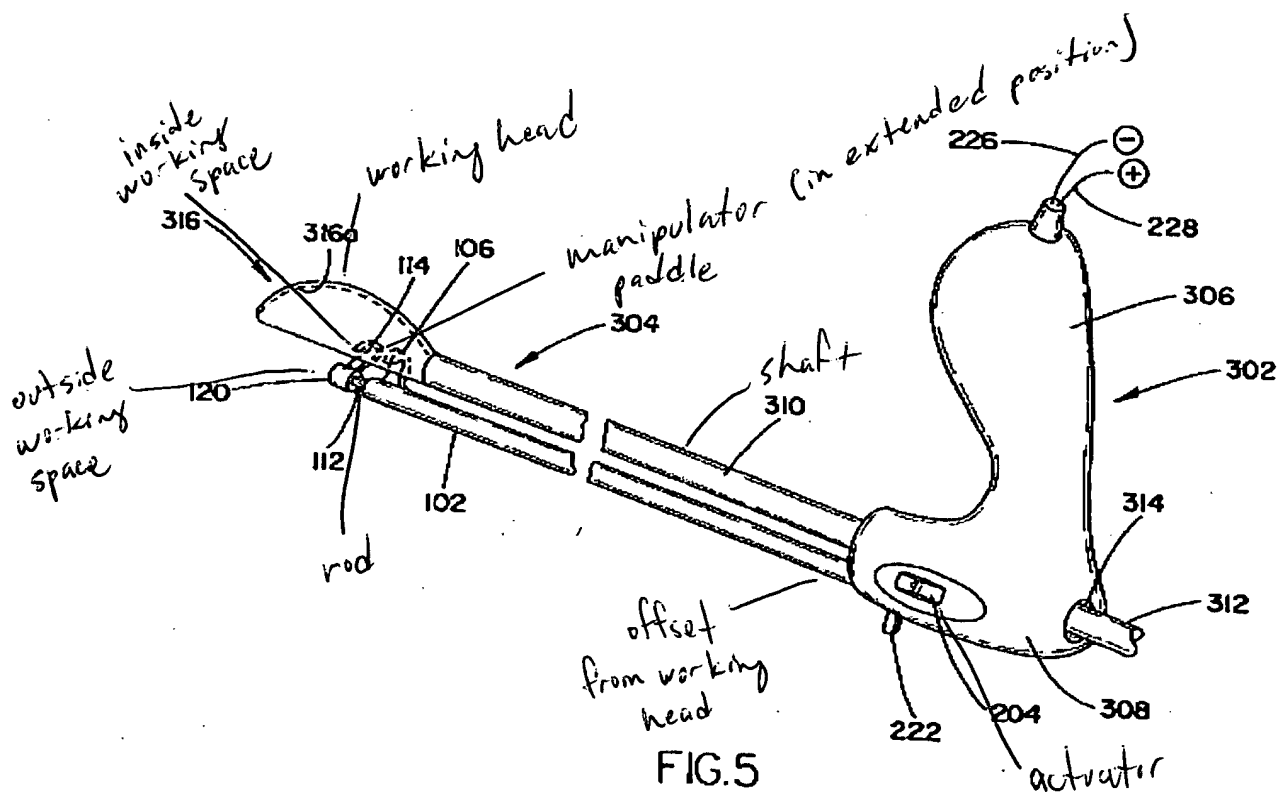
Art Unit: 3734

wherein the first paddle extend at least partially outside the working space defined by the working head when the first paddle is in the extending position; wherein the first paddle has a curved portion; wherein the curved portion forms a concave surface that faces away from the working head when the first paddle is in the extended position; a handle; a shaft attached to the handle that attached to the handle at a proximal end and attached to the working head at a distal end; at least a first actuator operably connected to the first manipulator for moving the first manipulator from the retracted position to the extended position; wherein the working head is concave; wherein the working head is spoon-shaped; and wherein the working head is at least partially transparent (col. 7, lines 44-46)

8. As to claims 20-24, Weadock et al. teaches a method for creating operative space and manipulating a vessel, comprising the steps of: providing a retractor having at least a distal end shaped to defining a working space, a first manipulator having a retracted position and an extended position, the first manipulator disposed at least partially within the working space when the manipulator is in the retracted position (col. 4, lines 45-46); making an incision in a patient; inserting at least the distal end of the retractor into the incision; creating a working space in the tissue of the patient near the vessel with the distal end of the retractor (col. 7, lines 59-63); and manipulating the vessel by moving the first manipulator from the stowed position to the extended position; wherein the creating and manipulating steps can be performed using one hand; wherein the first manipulator is rotatably connected to the distal end of the retractor, and the manipulating step comprises moving the first manipulator relative to

Art Unit: 3734

the distal end of the retractor upon actuation of an actuator (col. 3, lines 52-56); wherein the first manipulator comprises a first rod and a first paddle attached to a distal portion of the first rod, and the manipulation step comprises rotating the paddle about an axis defined by the first rod to move the vessel away from the distal end of the retractor (col. 3, lines 52-56).



Allowable Subject Matter

9. Claims 13 and 14 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claims 25-26 are allowable over the prior art of record.

Art Unit: 3734

11. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or render obvious the overall claimed invention of an instrument for manipulating a vessel in a patient comprising: a working head shaped to define a working space in the tissue of a patient; a first manipulator disposed within the working space having at least a first portion and a second portion, the first and second portion connected by an intermediate portion; and a second manipulator disposed within the working space having a mating portion configured to be disposed between the first and second portion of the first manipulator when the first and second manipulators are in the stowed position.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MM

A handwritten signature in black ink, appearing to read "M J Hayes", is positioned above the printed name.

MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER